



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,914	08/06/2003	James P. Burnie	050885-0305374	6486

43569 7590 12/15/2005

MAYER, BROWN, ROWE & MAW LLP  
1909 K STREET, N.W.  
WASHINGTON, DC 20006

EXAMINER
----------

BASKAR, PADMAVATHI

ART UNIT	PAPER NUMBER
----------	--------------

1645

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/634,914	BURNIE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Padmavathi v. Baskar	1645	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/6/03</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1645

### DETAILED ACTION

1. Applicant's response to restriction 10/3/05 is acknowledged.

#### *Election*

2. Applicant's election of group I in the reply filed on 10/3/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

#### **Status of claims**

3. Claims 1-3 are pending.

Claims 1-2 are under examination.

Claim 3 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 10/3/05

#### *Priority*

4. This application 10/634,914 is a continuation of 09/889,314 filed 11/20/01, ABN, was a national stage entry of PCT/GB00/00237, 1/28/2000 which claims priority under 35, U.S.C. 119 (a)-(d) to UNITED KINGDOM 9902555.3, 02/05/1999.

#### ***Specification - Informalities***

5. Title of the invention is not descriptive to the claimed invention. Applicant is advised to amend the title to recite the claimed invention (for example: *C.pneumoniae* polypeptides in the treatment of Chlamydial infection)

Applicants are advised to update the status of the application 09/889,314 filed on 11/20/01, Abandoned.

Art Unit: 1645

***Information Disclosure Statement***

6. The Information Disclosure Statement filed on 8/6/03 is acknowledged and a signed copy attached to this office action.

***Claim Rejections - 35 USC 112, second paragraph***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected as being vague and indefinite for the recitation of "polypeptide consisting of a peptide having SEQ.ID.NO: 16 "because it is not clear whether the claimed isolated polypeptide consists one peptide having SEQ.ID.NO: 16 or more. Does applicant intend to mean to recite "an isolated polypeptide consisting of the amino acid sequence as set forth in SEQ.ID.NO: 16 "?

***Claim Rejections - 35 USC 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 1645

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Izutsu et al U.S. Patent 6,165,478.

Claims are directed to an isolated polypeptide consisting of a peptide having SEQ.ID.NO: 16 and a composition comprising said peptide and carrier.

Hiroshi Izutsu et al disclose an isolated polypeptide consisting of a peptide (i.e., SEQ.ID.NO: 5) having the claimed SEQ.ID.NO: 16 from position 164-177 (see sequence alignment of the claimed protein SEQ.ID.NO: 16 with SEQ.ID.NO: 5 of the prior art) and is 100% identical to the claimed SEQ.ID.NO: 16. The disclosed polypeptide has been used in a composition for diagnosis of Chlamydia infection comprising an antigen, polypeptide SEQ.ID.NO: 5 (column 33, lines 12-17). The antigen used in the immunoassays is in general in hydrophilic phase, buffer or saline and is inherent in preparation of antigen. The prior art anticipated the claimed invention.

11. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Izutsu et al Accession Numbers AAR94585, AAR94579, AAR94586 or AAWO 1743.

The claims have been discussed supra.

Accession Numbers AAR 94585, AAR 94579, AAR 94586 and AAWO 1743 disclose an isolated *C.pneumoniae* polypeptide, clone 53-3S consisting of a peptide having the 271 amino acid sequence (see sequence alignment of the claimed protein SEQ.ID.NO: 16 with the prior art protein sequences). The disclosed prior art polypeptide AAR 94585, AAR 94579, AAR 94586 and AAWO 1743 are 100% identical with the claimed polypeptide having SEQ.ID.NO: 16 and is used in the composition comprising said polypeptide in a physiological solution (carrier) in the diagnosis of Chlamydial infection (see the abstract in the alignment). The antigen used in the

Art Unit: 1645

immunoassays is in general in hydrophilic phase, buffer or saline and is inherent in preparation of antigen. The prior art anticipated the claimed invention.

12. No claims are allowed.

### **Conclusion**

13. Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center, which receives transmissions 24 hours a day and 7 days a week. The transmission of such papers by facsimile must conform to the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The Right Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Padma Baskar Ph.D., whose telephone number is ((571) 272-0853. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 6.30 a.m. to 4.00 p.m. except First Friday of each bi-week.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

  
Padma Baskar Ph.D.

  
**LYNETTE R. F. SMITH**  
**SUPERVISORY PATENT**  
**TECHNOLOGY CENTER**